REMARKS

This is a response to the Office Action dated March 31, 2004. Claims 157-168, 170-186 and 188-199 are pending in this application. In the Office Action, claim 157 was rejected under 35 U.S.C. § 101 as being directed to two statutory classes. Claim 192 was also rejected under 35 U.S.C. § 101 as lacking utility. Additionally, claims 157-168, 170-186 and 188-199 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,737,539 to Edelson et al. ("Edelson et al.") in view of AMWAY® Products Delivered on your Schedule, Customer Order Worksheet, published 06/24/1998 ("Amway").

The rejections from the Office Action of March 31, 2004 are discussed below in connection with the various claims. No new matter has been added. Reconsideration of the application is respectfully requested in light of the following remarks.

I.   REJECTIONS UNDER 35 U.S.C. § 101

Independent claims 157 was rejected under 35 U.S.C. § 101 as being directed to two statutory classes. With this response, claim 157 has been amended for clarity. Applicants submit that claim 157, as amended, is directed to a single statutory class, and is therefore patentable.

Independent claims 192 was rejected under 35 U.S.C. § 101 as lacking utility. With this response, claim 192 has been amended for clarity. Applicants submit that claim 192, as amended, meets the statutory requirement for utility, and is therefore patentable.

II.   REJECTIONS UNDER 35 U.S.C. § 103(a)

A.   Independent Claims 157, 174, 192, 195 and 197

Independent claims 157, 174, 192, 195, and 197 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Edelson et al. or Edelson et al. in view of Amway.

Independent claim 157 requires generating a profile that specifies a recurrence of an order so that the order automatically recurs one or more times. Likewise, independent claim

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174 requires an order management system operative to generate a profile that specifies a recurrence of an order so that the order automatically recurs one or more times. Similarly, independent claim 192 requires repetitively sending a product or repetitively providing a service in response to establishing an automated order. Independent claim 197 similarly requires providing a standing order profile operable to allow a user to set up an automated order system that sends products and/or services to the user at regular intervals. In a similar manner, independent claim 195 requires establishing a standing order. A standing order is an order that repeats or recurs.

Contrary to the allegation by the Examiner in the Office Action, Edelson et al. does not suggest automatically repeating an order, an order that automatically recurs, a standing order or sending products and/or services to the user at regular intervals. Edelson et al. discloses an "...electronic prescription creation system for use by professional prescribers at the point of care [which] has a prescription division subsystem permitting creation of a single prescription to be automatically divided into two components for fulfilment [sic] of one portion quickly and locally at higher cost and of another portion by remote mail order taking more time but providing a cost saving for a major part of the prescription. The prescription creation system has an ability to access remote source databases for system presentation to the prescriber of relevant, authorized and current drug, drug formulary and patient history information, with dynamic creation of a transient virtual patient record, the information being presented to the prescriber before completion of the prescription, permitting enhancement of the quality of prescribing decisions." *See* Edelson et al., Abstract.

The Examiner points to a prescription quantification procedure of Edelson et al. as evidence that the Edelson et al. system causes an order to recur automatically. Applicants respectfully traverse. The prescription quantification procedure of Edelson et al. provides a mechanism for, "The Form, Size, Route and Amounts headers 92-98 [to be] linked to the drug selected and bring system resources to bear to enable a prescriber rapidly to quantify the prescription with appropriate dosages that can be filled at a pharmacy, without undue difficulty." (col. 25, lines 36-40). Thus, Edelson et al merely discloses a system that allows a prescriber to easily specify the quantity of a *single* prescription, to be fulfilled *once* at a pharmacy.

The Examiner also points to references to the number of allowable refills of a prescription as evidence of recurrence. Applicants respectfully submit that one of ordinary skill in the art would not equate an allowable refill of a prescription to a recurrence of an order. A prescription refill only specifies the maximum number of allowable refills of a prescription. When the current prescription runs out, the patient may or may not actually refill the order depending on the patient's condition. In contrast, an order in the present system will automatically recur according to the specified recurrence.

In short, Edelson et al. does not disclose or suggest a system that automatically fulfills an order according to a specified recurrence. At best, Edelson discloses a system that will split a *single* prescription to be fulfilled partially at a local pharmacy at a higher cost and the remainder from a mail order or similar prescription fulfillment service at a lower cost. *See* Edelson, Abstract; *See also,* Edelson, Col. 26 line 55 – Col. 27, line 8. Thus, a *single* prescription will be fulfilled from multiple sources. In contrast, the system of the present invention causes, automatically, an order to recur according to a specified recurrence.

For at least these reasons, independent claims 157, 174, 192, 195, and 197 are not obvious in view of Edelson et al. or the combination of Edelson et al. and Amway. Accordingly, Applicants request that the Examiner withdraw this rejection of independent claims 157, 174, 192, 195, and 197.
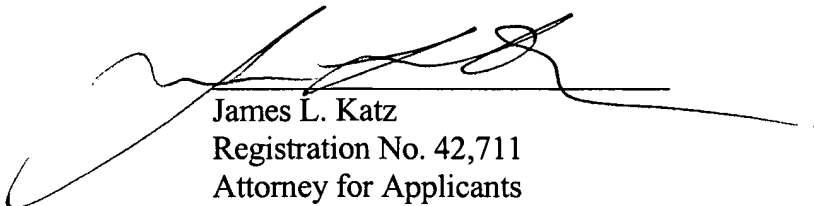
B.   Dependent Claims 158-173, 175-191, 193, 194, 196 and 198-199

Dependent Claims 158-173, 175-191, 193, 194, 196 and 198-199 were also rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Edelson et al. in view of Amway. Dependent claims 158-173, 175-191, 193, 194, 196 and 198-199 should be allowed for the reasons set out above for the independent claims. Applicants therefore request that the Examiner withdraw this rejection of these claims. Further limitations of the dependent claims are not disclosed by either of the Edelson or Amway references. For example, neither discloses: receiving multiple orders as claimed in claims 165 and 183; user modification of the profile as claimed in claims 166-169 and 184-187; generating a profile as defined in the claims from a shopping cart as claimed in claims 170 and 188; and a member or IBO as claimed in claims 162 and 178.

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The Examiner is invited to call the undersigned if it would expedite the prosecution of this application.

Respectfully submitted,

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